IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Tobias Mochel et al.	Art Unit	: 1625
Serial No.	: 10/599,700	Examiner	: Nizal S. Chandrakumar
Filed	: February 16, 2007	Conf. No.	: 2947
Title	: PIPERIDINE DERIVATIVES FOR THE TREATMENT OF CHEMOKINE MEDIATED DISEASE		

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement ("the RR") having a mail date of October 28, 2008, Applicants elect Group I, "claims1-8 and 10, drawn to compounds" (RR, page 2).. The election is made **with** traverse. This is discussed in more detail below.

[1] The present application is the U.S. National Stage of International Application No. PCT/SE2005/000495, filed on April 5, 2005. As such, the present application is subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499 (see MPEP § 1896). See also MPEP 1893.03(d):

> Examiners are reminded that unity of invention **>(not restriction practice pursuant to 37 CFR 1.141 - 1.146)< is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371.

[2] 37 CFR 1.475 provides as follows (emphasis added):

> a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). **Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.** The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
>
> (b) **An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories**:
>
> (1) A product and a process specially adapted for the manufacture of said product; or
>
> (2) A product and process of use of said product; or
>
> **(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product**; or
>
> (4) A process and an apparatus or means specifically designed for carrying out the said process; or
>
> (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.
>
> (c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.
>
> (d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

[3] Presently, the Office is requiring that Applicants elect one of the following groupings of claimed subject matter (Office Action, page 2):

Group I, claim(s) 1-8, 10, drawn to compounds.

Group II, claim(s) 9, drawn to process of making compounds.

Group III, claim(s) 13, drawn to method of treating diseases.

37 CFR § 1.475(b)(3) states that a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to a combination of "[a] product, a process specially adapted for the manufacture of the said product, and a use of the said product" (*supra*). Here, claim 9 is directed to a process for the preparation of a compound of formula (I); and claim 13 is directed to methods of treating a chemokine mediated disease state, which include administering a compound of formula (I). As such, each of claims 9 and 13 shares a special technical feature: the compounds of formula (I), which is also the same special technical feature required by claim 1. Thus, the present claims are drawn to a combination of "[a] product, a process specially adapted for the manufacture of the said product, and a use of the said product." As such, the present claims are unified, and claims 9 and 13 should be rejoined and examined in concert with claims 1-8 and 10 for at least this reason.

Applicants note that the Office **must** follow PCT Rule 13 and not national practice in these determinations. Thus, even if the Groups were properly restricted under national practice (and Applicants do not concede that to be the case), PCT Rule 13 requires, in this case, rejoinder of the Groups. Thus, all claims, regardless of whether they are compound, method of using, or process of making possess unity in the present case and should be examined in concert in the present application.

No fee is believed due. Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 06275-523US1 / 101400-1P US.

Respectfully submitted,

Date: November 26, 2008

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